

REMARKS/ARGUMENTS

1.) Claim Amendments

Subsequent to the issuance of the present Final Office Action, multiple discussions were had with the Examiner regarding proposed amendments to the claims to place them in condition for allowance. The amendments to claim 50, as presented herein, were in response to the Examiner's proposal of amendments for which he would allow the claims. It is also noted that the limitation of "when said delay reducing information indicates that said traffic volume of the data to be transmitted is above said pre-configured threshold . . ." was previously presented in claim 100, which has been cancelled. Independent claim 67 has been similarly amended to include that limitation from claim 101, which has also been cancelled.¹ **The foregoing amendments do not add new subject matter.** Also during such discussions, the Examiner preliminarily agreed that claim 50, as amended, would distinguish over the presently-cited prior art. Subsequently, however, he indicated that his SPE had identified a new reference (U.S. Patent No. 7,099,346) and indicated that Applicants would need to also distinguish over that reference. After sending the Examiner unofficial comments as to why claim 50 is also distinguishable over the new reference, the Examiner nevertheless indicated that he would allow the case only if claim 50 (and each of the other independent claims) was amended to include the subject matter of claim 56. For the reasons presented *supra*, however, the Applicants do not believe that it is necessary to rely on the subject matter of claim 56 to distinguish the claims over the presently-cited prior art.²

2. Rebuttal of Examiner's "Response to Arguments"

In responding to the Applicants' previously-submitted arguments, the Examiner first states that the arguments "have been considered but are moot in view of the new ground(s) of rejection. The Examiner then provides certain comments that the claim limitation "wherein the data transfer initiating message is an uplink cell update message

¹ A similar limitation was already included in independent claim 99.

² The Applicants also do not believe that it is necessary to rely on the subject matter of claim 56 to distinguish the claims over the unofficially-cited new reference; the Applicants will submit official arguments if the Examiner first issues an office action based on that reference.

transmitted by the UE . . . has been given little weight within the claims because it does not add further structure to apparatus claims or further steps to process claims nor does it add further function to the structure of steps.” The Applicants disagree with this characterization of that portion of the claims. A cell update message is a specific type of message which, according to the principles of the Applicants’ invention, is specifically modified in order to initiate a data transfer in a novel way. There is nothing about the language of that claim limitation that merely “suggests” or “makes optional” the recited feature. Accordingly, it is respectfully requested that the Examiner give the limitation full weight when considering the merits of the invention in view of the cited prior art.

3.) Claim Rejections – 35 U.S.C. §103(a)

The Examiner has now rejected claims 50, 67, and 99 as being unpatentable over Sharma (U.S. Patent No. 7,406,314 82; U.S. Provisional Application No. 60/486,584) and Vadgama (U.S. Patent No. 7,277, 709 B2); and, claims 53-57, 70-81, and 100-101 as being unpatentable over Sharma, Vadgama and Wallentin, *et al.* (US Pat. No. 6,594,238 B1). The Applicants traverse the new basis of rejection.

Before considering the merits of the Examiner’s new basis of rejection, it will be helpful to review the prosecution history:

- 1.) The Examiner first rejected claim 50 as anticipated by Wallentin in an Office Action dated March 4, 2009.
- 2.) In responding to that basis of rejection on June 4, 2009, the Applicants amended claim 50 to include the limitations of original claims 51 and 52, which the Examiner had also rejected as anticipated by Wallentin, and submitted arguments to distinguish claim 50 over the teachings thereof.
- 3.) The Examiner maintained the rejection of claim 50, as anticipated by Wallentin, in a Final Office Action dated September 14, 2009.
- 4.) The Applicants filed a response to the Final Office Action on November 16, 2009, wherein the limitations of claim 50 were restructured without adding any new substantive matter, and arguments were again submitted to traverse the rejection thereof in view of Wallentin.

- 5.) The Examiner then issued an Advisory Action, dated December 4, 2009, which indicated that the claim amendments would not be entered and that the amendments “changed the scope of all the claims which require a further search/consideration.”
- 6.) The Applicants then filed a Request for Continued Examination on January 14, 2010, based on the amendments and arguments previously submitted in response to the Final Office Action.
- 7.) The Examiner then issued a Non-Final Office Action on July 22, 2011, rejecting all of the claims as obvious **over Sharma in view of Wallentin**.
- 8.) The Applicants submitted a response, traversing the rejection of all claims as obvious over Sharma in view of Wallentin on October 24, 2011; the response also included a minor clarification of independent claims 50 and 67 and the addition of independent claim 99, having analogous limitations.
- 9.) The Examiner then issued the present Final Office Action, **removing Wallentin** as the secondary reference for his rejection of the independent claims³, and substituting therefor the teachings of Vadgama.

For the reasons that follow, Vadgama fails to cure the deficiencies in the teachings of Wallentin, as previously identified by Applicants, in the teachings of Sharma.

The Examiner has again recognized that Sharma fails to teach the essential and critical limitations of claim 50. To overcome the acknowledged deficiencies, the Examiner now looks to the teachings of Vadgama. The teachings of Vadgama are directed to “cell selection techniques”, wherein a “decision as to whether to use a cell for data transmission is made in dependence on a measure of a congestion level in the cell.” (Abstract) The Examiner states that Vadgama teaches “the user equipment measuring congestions in cells, making a cell selection based on the congestion levels based on the usage of shared transmission channels.” (Office Action; page 4, line 12, *et seq.*) The Examiner makes further statements to the effect that Vadgama teaches cell selection, by a mobile station, based on cell congestion levels. **But that is not what the**

³ The Examiner has retained Wallentin as a secondary reference with respect to the rejection of dependent claims 53-57, 70-81, 100 and 101 (the limitations of claims 100 and 101 have been added to claims 50 and 67, herein, and those claims have been cancelled.)

Applicants have claimed. The Applicants invention does not have anything to do with cell selection, much less any type of selection based on cell congestion. Rather, the Applicants' invention is directed to initiating a data transfer by a User Equipment (UE; e.g., a "mobile station"), and is characterized by a data transfer initiating message including delay reducing information. In particular, the data transfer initiating message is an uplink cell update message transmitted by the UE, wherein the delay reducing information comprises information indicating whether the traffic volume of the data to be transmitted by the UE is above a pre-configured threshold. When the delay reducing information indicates that the traffic volume of the data to be transmitted is above the pre-configured threshold, a Radio Network Controller (RNC) that receives the data transfer initiating message sends a message to the UE that causes it to transfer from a URA PCH or CELL PCH state directly to a CELL DCH state. Neither Sharma nor Vadgama disclose that combination of elements and functionality and, therefore, the Examiner has not established a *prima facie* case of obvious of claim 50 in view of those references.

Whereas independent claims 67 and 99 recite limitations analogous to those of claim 50, they are also not obvious over Sharma and Vadgama. Furthermore, whereas claims 53-57 are dependent from claim 50 and claims 70-81 are dependent from claim 67, and include the limitations of those base claims, those claims are also not obvious in view of Sharma and Vadgama.

* * *

CONCLUSION

In view of the foregoing remarks, the Applicants believe all of the claims currently pending in the Application to be in a condition for allowance. The Applicants, therefore, respectfully request that the Examiner withdraw all rejections and issue a Notice of Allowance for claims 50, 53-57, 67, 70-81 and 99.

The Applicants request a telephonic interview if the Examiner has any questions or requires any additional information that would further or expedite the prosecution of the Application.

Respectfully submitted,

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